

Remarks

Applicant respectfully requests reconsideration of this application in view of the present amendments and the following remarks. Upon entry of the amendments, claims 1-49 are pending and at issue, with claims 1, 9, 17, 25, 33 and 41 being independent claims. It is believed that no additional fees beyond the \$110.00 petition fee for a one-month extension of time are due for the consideration of this paper. However, if additional fees are due, the Commissioner is authorized to charge such fees to deposit account number 13-2855. A copy of this paper is enclosed.

Independent claims 1, 9, 17, 25, 33 and 41 are amended hereby to more clearly recite that the value-dispensing mechanism dispenses the bonus payout to the user prior to returning to the main gambling game. As a result, the bonus payout may be dispensed or distributed to the user separately from any currency payout associated with the outcome of the main gambling game. These revisions to claims 1, 9, 17, 25, 33 and 41 are supported in the specification as originally filed at least at FIG. 11 and the accompanying text at page 16, line 26 through page 18, line 21, wherein the processor 70 may dispense a bonus round game award based on various criteria instead of applying the bonus round award or credits toward playing the main gambling game. Consequently, no new matter is added by the amendments to independent claims 1, 9, 17, 25, 33 and 41.

Dependent claims 3, 11, 19, 27, 35 and 42 are amended to more clearly recited that the bonus payout may be dispensed to the user prior to returning to the main gambling game based on user preference information corresponding to data stored on an item read by an electronic reader. Additionally, claims 4, 12, 20, 28, 36 and 43 are amended to more clearly recited that the bonus payout may be dispensed to the user prior to returning to the main gambling game based on user preference information received from a player tracking system. These revisions to claims 3, 4, 11, 12, 19, 20, 27, 28, 35, 36, 42 and 43 are supported in the specification as originally filed at least at FIG. 11 and the accompanying text at page 17, lines 16-28, wherein the processor 70 may dispense a bonus round game award based on player profile information that may be stored, for example, on the user's smart card or in the user's profile on a player tracking system. Consequently, no new matter is added by the amendments to dependent claims 3, 4, 11, 12, 19, 20, 27, 28, 35, 36, 42 and 43.

Dependent claims 5, 13, 21, 29, 37 and 44 are amended to more clearly recited that the bonus payout may be dispensed to the user prior to returning to the main gambling game based on user preference information entered by the user via the input device. These revisions to claims 5, 13, 21, 29, 37 and 44 are supported in the specification as originally filed at least at FIG. 11 and the accompanying text at page 17, lines 16-28, wherein the processor 70 may dispense a bonus round game award based on selections that may be made by the user at an input device, such as a touch sensitive input device, that may cause the controller 70 to pay out accumulated bonus credits or awards. Consequently, no new matter is added by the amendments to dependent claims 5, 13, 21, 29, 37 and 44.

In the Office action of October 4, 2002, claims 1-5, 7, 9-13, 15, 17-21, 23, 25-29, 31, 33-37, 39, 41-44, 46, 48 and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Salomiany *et al.* (U.S. Patent No. 6,159,098) in view of Gilmore *et al.* (U.S. Patent No. 6,347,996), claims 6, 14, 22, 30, 38 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Salomiany *et al.* in view of Gilmore *et al.* an in further view of Burns *et al.* (U.S. Patent No. 6,048,269) and Sunders *et al.* (U.S. Patent No. 6,340,331), and claims 8, 16, 24, 32, 40 and 47 were rejected under §103(a) as being unpatentable over Salomiany *et al.* in view of Gilmore *et al.* an in further view of Adams *et al.* (U.S. Patent No. 6,113,098). Applicant respectfully traverses the rejections of claims 1-49 and respectfully submits that claims 1-49 as amended herein would not be properly rejectable over the applied references for the following reasons.

Regarding the rejection of claims 1-5, 7, 9-13, 15, 17-21, 23, 25-29, 31, 33-37, 39, 41-44, 46, 48 and 49 over Salomiany *et al.* in view of Gilmore *et al.*, applicant respectfully submits that the Salomiany *et al.* and Gilmore *et al.* references do not appear to disclose or suggest an electronic gambling unit having a main gambling game and a bonus round game in which a value-dispensing mechanism dispenses a bonus payout to the user after determining the bonus payout and prior to returning to the main gambling game. Salomiany *et al.* appears to disclose a gaming machine having a main game and a bonus game for which a player may be awarded coins or credits upon completion. *See, e.g.,* Salomiany *et al.*, col. 2, lines 13-17 and col. 9, lines 18-21. However, Salomiany *et al.* neither discloses nor suggests that any award from the bonus game is actually

dispensed from the gaming machine to the user at any time other than the same time that any award from the main game is dispensed to the user. The specification of Salomiany *et al.* contains no disclosure whatsoever of the timing of dispensing any awards to the player. The only suggestion of dispensing any awards to the player appears in Fig. 1a, and in fact appears to teach away from dispensing an award for a bonus game separately from any other awards. In Fig. 1a, the illustrated slot machine 10 appears to include a "CASH OUT" button that appears to cause the slot machine 10 to dispense any accumulated awards or credits together. At a minimum, no text in Fig. 1a or description in the specification is provided that suggests that the "CASH OUT" button would cause the slot machine 10 to dispense any amount other than the full amount of awards or credits accumulated by the player. Therefore, the Salomiany *et al.* reference does not disclose or suggest, and in fact teaches away from, dispensing an award for a bonus game prior to returning to a main gambling game as recited in the claims.

The Gilmore *et al.* reference fails to provide the disclosure or suggestion missing from the Salomiany *et al.* reference of dispensing a bonus game award prior to returning to a main gambling game. Gilmore *et al.* discloses a gaming machine having a basic game and a bonus feature. The Gilmore *et al.* reference discloses that the player may collect the amount of **accumulated credits** by pressing the "Collect" button 60. Gilmore *et al.*, col. 3, lines 39-41. Similar to Salomiany *et al.*, Gilmore *et al.* teaches away from dispensing a bonus payout separately from any other accumulated credits by disclosing an all-or-nothing cash out or collect button. It follows, therefore, in the opinion of the applicant that the Salomiany *et al.* and Gilmore *et al.* references applied by the examiner neither anticipate nor render obvious claims 1-5, 7, 9-13, 15, 17-21, 23, 25-29, 31, 33-37, 39, 41-44, 46, 48 and 49, and in fact teach away from the invention recited in these claims. See *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985) (the prior art must make a suggestion of or provide an incentive for the claimed combination of elements in order to establish a *prima facie* case of obviousness). Because the applied references do not appear to teach or suggest an electronic gambling unit having a main gambling game and a bonus round game in which a value-dispensing mechanism dispenses a bonus payout to the user after determining the bonus payout and prior to returning to the main gambling game, and in

fact teach away from dispensing a bonus payout separately from any other accumulated credits, applicant respectfully submits that claims 1-5, 7, 9-13, 15, 17-21, 23, 25-29, 31, 33-37, 39, 41-44, 46, 48 and 49 are now in condition for allowance, and applicant respectfully requests allowance of these claims at the Examiner's earliest convenience.

In addition to the reasons discussed above, claims 3-5, 11-13, 19-21, 27-29, 35-37 and 42-44 are neither anticipated nor rendered obvious by the proposed combination of the Salomiany *et al.* and Gilmore *et al.* reference for at least the following additional reasons. Regarding claims 3, 11, 19, 27, 35 and 42, neither reference discloses or suggests dispensing a bonus payout prior to returning to the main gambling game based on user preference information corresponding to data stored on an item, such as a player tracking card. While Salomiany *et al.* may illustrate a slot machine 10 with what appears to be a slot for receiving a player tracking card in Fig. 1a, the reference does not appear to discuss an item having data stored thereon at all, let alone an item with user preference information corresponding to the data stored thereon to cause the gambling unit to dispense a bonus payout prior to returning to the main gambling game as recited in the claims. Moreover, with respect to claims 4, 12, 20, 28, 36 and 43, regardless of whether player tracking systems are or are not "notorious" as asserted by the examiner, Salomiany *et al.* does not appear to disclose or suggest any player tracking system whatsoever, let alone a player tracking system providing user preference information to the gambling unit to cause the unit to dispense a bonus payout prior to returning to the main gambling game as recited in these claims. Additionally, Gilmore *et al.* does not provide the disclosure of items having data stored thereon or player tracking systems as recited in the claims and missing from the Salomiany *et al.* reference. Therefore, for these additional reasons, claims 3, 4, 11, 12, 19, 20, 27, 28, 35, 36, 42 and 43 are not anticipated or rendered obvious by the Salomiany *et al.* and Gilmore *et al.* references.

Regarding claims 5, 13, 21, 29, 37 and 44, the applied references do not disclose or suggest dispensing a bonus payout before returning to the main gambling game based on user preference information entered at an input device. As previously discussed, Salomiany *et al.* and Gilmore *et al.* teach or suggest an all-or-nothing cash out or collect button causing the gambling machine to dispense all the accumulated credits, and not just a bonus payout as recited in the claims. Consequently, the reference do not appear to

disclose or suggest providing an input device wherein the user may enter user preference information to cause the gambling unit to dispense a bonus payout prior to returning to the main gambling game. Therefore, claims 5, 13, 21, 29, 37 and 44 are neither anticipated nor rendered obvious by Salomiany *et al.* and Gilmore *et al* for this additional reason.

Finally, applicant respectfully requests withdrawal of the rejections of claims 6, 8, 14, 16, 22, 24, 30, 32, 38, 40, 45 and 47 for the reasons discussed above. The additional applied references, Burns *et al.*, Saunders *et al.* and Adams *et al.*, do not provide the necessary teaching or suggestion missing from Salomiany *et al.* and Gilmore *et al.* of an electronic gambling unit having a main gambling game and a bonus round game in which a value-dispensing mechanism dispenses a bonus payout to the user after determining the bonus payout and prior to returning to the main gambling game. The additional applied references do not appear to disclose or suggest a bonus game, let alone dispensing a bonus payout from a bonus game prior to returning to the main gambling game. Therefore, for the same reasons discussed above, claims 6, 8, 14, 16, 22, 24, 30, 32, 38, 40, 45 and 47 are neither anticipated nor rendered obvious by the combinations of references proposed by the examiner and, consequently, applicant respectfully requests allowance of these claims at the Examiner's earliest convenience.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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